



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

09/853,094

05/09/2001

Mark R. Dee

36861.00.0006

5243

7590

07/27/2006

Angelo J. Bufalino
VEDDER PRICE KAUFMAN & KAMMHOLZ
222 N. LaSalle Street
Chicago, IL 60601

EXAMINER

RUHL, DENNIS WILLIAM

ART UNIT

PAPER NUMBER

3629

DATE MAILED: 07/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/853,094	DEE, MARK R.	
	Examiner	Art Unit	
	Dennis Ruhl	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5, 11, 13-15, 18-22 and 50-69 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 5, 11, 13-15, 18-22 and 50-69 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Applicant's response of 2/10/06 has been entered. The examiner will address applicant's remarks at the end of this office action.

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 5,11,13-15,18-22,50-69, are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

For claim 50, applicant has specifically recited that the system comprises "an occupant". This is the same as claiming a person in an apparatus claim and this is not statutory. People are not allowed to be claimed in apparatus claims.

For claims 20-22,56,58,63-67, applicant is reciting a method step of using the recited structure of the system. This is improper because a claim can only fall into one statutory class of invention at one time. This claim is dependent from an apparatus claim but is reciting a method step by using recited structure of the system, which is a mixing of two distinct statutory classes of invention. This renders the claims as non-statutory.

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 11,13-15, are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter

which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

For claims 11,13,14, the specification as originally filed did not disclose that there was a reference tag and/or a reference tag with a bar code designation that has wireless communication means, and did not disclose a license plate that has wireless communication means. The specification as originally filed disclosed two kinds of reference identifiers, one kind having wireless communication ability, the other kind did not have wireless communication ability. Page 13 discloses that the reference identifier tag is a visual reference identifier, not a wireless identifier. The disclosed license plate does not have wireless communication means because it is just a visual identifier. The most recent amendment has introduced new matter into the claims because the reference identifier tag and the license plate were not disclosed as having wireless communication means in the specification as originally filed. By claiming that the reference identifier has wireless communication means in claim 50, applicant is essentially limiting claim 50 to those embodiments where the reference identifier has wireless communication means. The embodiments of the reference tag and the license plate have effectively been excluded from the scope of claim 50 because they do not have wireless communication means. Claims 11,13,14, contain new matter.

For claim 15, the specification as originally filed did not disclose that the reference identifier that has wireless communication means can be a vehicle number. This is a similar issue to that mentioned with respect to claims 11,13,14, in that a

Art Unit: 3629

vehicle number does not have wireless communication means so the amendment has introduced new matter in the claim. It was never disclosed that there is an embodiment where the reference identifier is a number that has wireless communication means.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 5,11,13-15,18-22,50-69 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

For claim 50, there is no antecedent basis for "said parking location accounting system" and "said geographical region". In the most recent amendment applicant canceled the language that first claimed the accounting system but left other language in the claim that uses "said" with respect to the accounting system, so is the accounting system part of the scope of this claim? With respect to the geographical region, what region is this referring to? None has previously been recited.

For claims 11,13,14,15, it is not clear as to what the scope of the claims is. Claim 50 recites that the reference identifier has wireless communication means; however, the embodiments of the reference tags, the license plate, and the vehicle number that are claimed in claims 11,13,14,15, do not have wireless communication means. It is not clear as to whether or not the scope of the claims requires that the reference identifier have wireless communication means (as recited in claim 50) or not,

Art Unit: 3629

because the embodiments recited in claims 11,13,14 do not have wireless communication means.

For claim 20, one wishing to avoid infringement would not know the scope of the claim. The reason is that one wishing to avoid infringement would not know whether or not they were infringing by just possessing the claimed structure of the invention, or if they were infringing only when using the claimed device in the claimed manner. The claim is indefinite for this reason. The examiner notes that applicant changed the claim from reciting functional language to now reciting the actual performing of the step. Also in claim 20, what is meant by the language "by entering the reference identifier into the wireless ticket issuance device"? Is this supposed to mean that when the reference identifier is a license plate, that the license plate is removed from the vehicle and is placed inside the ticket device? The reference identifier is a tangible element of the system so it is not clear to the examiner how applicant can claim that the reference identifier is entered into the ticket device. It may be that information obtained from the reference identifier can be entered into the ticket device, but that is not what the claim is reciting. Correction is required.

For claims 21,22,56,58,63-67, one wishing to avoid infringement would not know the scope of the claim. The reason is that one wishing to avoid infringement would not know whether or not they were infringing by just possessing the claimed structure of the invention, or if they were infringing only when using the claimed device in the claimed manner. The claim is indefinite for this reason. The examiner notes that applicant

changed the claim from reciting functional language to now reciting the actual performing of the step.

For claim 62, is the recited "wireless communication means" the same communication means as was recited in claim 50 or is this a recitation to a 2nd wireless communication means? This is not clear. How many wireless communication means are there for the reference identifier?

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 5,11,13-15,18-22,50-58,60-69, are rejected under 35 U.S.C. 103(a) as being unpatentable over Ouimet et al. (WO 97/37328) in view of Zeitman (WO 98/04080).

For claims 50,57,60,61,62,63,66,67, Ouimet discloses a parking payment system. There is inherently a vehicle, an occupant, a space and a location as claimed. The claimed reference identifier is considered to be the "smart card" that is disclosed by Ouimet on page 6. The smart card has wireless communication means because a smart card communicates data wirelessly and has a processor. This is inherent to a smart card. The examiner takes "official notice" of this fact. The wireless ticket issuance device is 18, and communicates with a central processing means 16. The parking meter is 12 and has wireless communication means 41. The parking meter and the

Art Unit: 3629

central processing means can credit an accounting system with payment received as claimed. The central processing means (computer 16), credits an accounting system with payment received as claimed, records start times for parking (so you can determine when a vehicle is illegally parked due to exceeding the time paid for parking), communicates status information to the wireless ticket devices 18, and records ticket information as claimed. Not disclosed is that there is a communication means to be used by the occupant to communicate with the central processing means. Zeitman discloses a parking management system that has a high level of user convenience. Zeitman discloses that the user can directly communicate with a central computer system by using their mobile telephone or a computer, and can provide the information such as vehicle space and time information by using their telephone. This would allow for more user convenience when conducting the parking space use transaction. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide Ouimet with the ability to take user information by a communication means (telephone, computer) as is disclosed by Zeitman so that the user has another convenient method by which to conduct the parking transaction.

For claim 5, the parking location can be reference by means of geographic positioning. This claim is not reciting any further structure to the system of claim 50. The manner in which the parking location is determined is not relevant to the system.

For claims 11,13,14, as best understood by the examiner due to the new matter and 112,2nd problems, the prior art is considered to satisfy what is claimed.

For claim 15, if one wanted to make the reference identifier a number, they could do so.

For claims 18,56,64, the 103 rejection results in a communication means that can communicate with the central processing means to add extra time as claimed. This feature is present in the resulting structure of the 103 combination.

For claims 19,65, the communication means is fully capable of being notified as claimed. The prior art has the ability to perform the functional recitation claimed.

For claims 20,21,22, as best understood by the examiner the prior art satisfies what is claimed. This is because the time status information is verified by the ticket machine in Ouimet by acquiring data about the vehicle. The manner in which that information is obtained is not given weight in an apparatus claim because that has to do with the method of use.

For claims 51-55,68,69, the prior art rejection results in the claimed structure. This is because the communication means of Zeitman (that was provided to the system of Ouimet) is disclosed as being a telephone (cell phone or landline) as well as a computer. This can be seen figure 1 of Zeitman. A computer and/or a cell phone can be considered as personal data assistants. The disclosed telephones are considered to be paging devices.

With respect to claim 58, reciting whom it is that issued the reference identifier is not seen as reciting any further structure to the system. Claiming who the reference identifier is issued from is not reciting any particular structure to the system or the reference identifier.

Art Unit: 3629

9. Claim 59 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ouimet et al. (WO 97/37328) in view of Zeitman (WO 98/04080) and further in view of Hassett (5351187).

For claim 59, not disclosed in the 103 combination is that the reference identifier is a radio frequency transponder. In Ouimet the reference identifier (the smart card that contains vehicle data and pre loaded parking funds) can be used to pay for parking by using pre-paid funds loaded onto the card. Hassett discloses a parking payment system where the user has a radio frequency transponder for their vehicle, where the transponder is preloaded with funds to be used to pay for parking. It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the reference identifier a radio frequency transponder as disclosed by Hassett because the transponder works in the same way as the smart card of Ouimet does and is considered to be a functional equivalent to the smart card. One of ordinary skill in the art would have found the use of the transponder as obvious. The transponder is just another way to use technology to accomplish the payment of parking funds, just like the smart card of Ouimet does.

10. Applicant's arguments filed 2/10/05 have been fully considered but they are not persuasive. Applicant has argued that the prior art does not disclose a reference identifier that has wireless communication means. The examiner disagrees and this has been addressed and explained in the rejection of record.

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dennis Ruhl whose telephone number is 571-272-6808. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 571-272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



DENNIS RUHL
PRIMARY EXAMINER